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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD PAUL LEWIS, PAUL FRANCIS TRAMONTINA,
DAVID W. KAPILOFF, STEPHEN L. PHELPS, DARRELL R. JOHNSON
and GERALD L. CLARK

Appeal 2009-003285
Application 10/750,238
Technology Center 3600

Decided: November 20, 2009

Before LINDA E. HORNER, JOHN C. KERINS, and KEN B. BARRETT,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Richard Lewis et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-11, 14-23, and 25-40. Claims 12, 13, and 24 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.

THE INVENTION

Appellants' claimed invention is a method and apparatus for dispensing predetermined lengths of sheet material. Spec. 1:5-7. Claims 1 and 26, reproduced below, are representative of the subject matter on appeal.

1. An apparatus adapted to dispense a web of sheet material from a continuous roll, the apparatus comprising:

a support configured to rotatably support a roll of sheet material which includes identification relating to absorbent characteristics of sheet material on the roll;

an identifier configured to identify the absorbent characteristics of sheet material on the roll from the identification;

a processor configured to receive data relating to the absorbent characteristics of the sheet material on the roll, the processor further configured to process the data and generate an output command; and

a controller configured to control the length of sheet material dispensed from the roll in response to the output command.

26. A method of dispensing a web of sheet material from a continuous roll, the method comprising:

providing a roll of sheet material which includes identification relating to absorbent characteristics of sheet material on the roll;

rotatably supporting the roll of sheet material adjacent an identifier in a dispenser housing;

identifying the absorbent characteristics of sheet material on the roll;

processing data relating to the absorbent characteristics of sheet material on the roll to generate an output command; and

controlling a length of sheet material dispensed from the roll in response to the output command.

THE EVIDENCE

The Examiner relies upon the following evidence:

Niada	US 5,452,832	Sep. 26, 1995
Alfano	US 6,069,354	May 30, 2000
Ardalan	US 6,363,057 B1	Mar. 26, 2002
Formon	US 6,419,136 B2	Jul. 16, 2002
Denen	US 2002/0117578 A1	Aug. 29, 2002
Yamakawa	US 6,894,711 B2	May 17, 2005
Narita	US 6,962,451 B2	Nov. 8, 2005

THE REJECTIONS¹

Appellants seek review of the following rejections by the Examiner:

1. Rejection of claims 1, 2, 5-8, 15-19, 21-23, 25-27, 29-31, 34-37, and 39 under 35 U.S.C. § 102(b) as anticipated by Denen.
2. Rejection of claim 14 under 35 U.S.C. § 103(a) as unpatentable over Denen.
3. Rejection of claim 20 under 35 U.S.C. § 103(a) as unpatentable over Denen and Niada.
4. Rejection of claim 32 under 35 U.S.C. § 103(a) as unpatentable over Denen and Yamakawa.
5. Rejection of claim 38 under 35 U.S.C. § 103(a) as unpatentable over Denen and Alfano.
6. Rejection of claim 40 under 35 U.S.C. § 103(a) as unpatentable over Denen and Ardalan.
7. Rejection of claims 1-4, 9, 14-16, 25, 27, 28, 32, and 35 under 35 U.S.C. § 103(a) as unpatentable over Formon and Yamakawa.
8. Rejection of claims 10, 11, and 33 under 35 U.S.C. § 103(a) as unpatentable over Formon, Yamakawa, and Narita.
9. Rejection of claim 40 under 35 U.S.C. § 103(a) as unpatentable over Formon, Yamakawa, and Ardalan.

ISSUES

The Examiner found that the requirements of claim 1 relating to absorbent characteristics of sheet material on the roll are functional only,

¹ To facilitate analysis, the sequence of the rejections in this opinion has been reordered from the sequence in the Answer.

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and recite an intended use. Ans. 11. The Examiner also found that Denen's device is capable of performing the recited function because the perforations may be related to the absorbent characteristics of the sheet material. *Id.*

Appellants argue claims 1, 2, 5-8, 15-19, and 21-23 as a group. App. Br. 5-7. As such, we select claim 1 as the representative claim, and claims 2, 5-8, 15-19, and 21-23 stand or fall with claim 1. Appellants present separate arguments for claims 25 and 26. App. Br. 7-9. Appellants contend that Denen fails to disclose the structure called for in independent claims 1 and 25 and fails to disclose the step of identifying the absorbent characteristics of sheet material, as called for in independent method claim 26. App. Br. 6-9.

The issues before us are:

Have Appellants shown the Examiner erred in rejecting claims 1 and 25 as anticipated by Denen because Denen fails to disclose the claimed structure?

Have Appellants shown the Examiner erred in rejecting claim 26 as anticipated by Denen because Denen fails to disclose the claimed method including the step of identifying the absorbent characteristics of sheet material?

The Examiner found that the proposed combination of the teachings of Formon and Yamakawa would have led to a device that is capable of performing the recited function because Formon's perforations may be related to the absorbent characteristics of the sheet material. Ans. 4-6, 12.

Appellants argue claims 1-4, 9, and 14-16 as a group. App. Br. 9-11. As such, we select claim 1 as the representative claim, and claims 2-4, 9, and 14-16 stand or fall with claim 1. Appellants present separate arguments for

claim 25, contending that Formon fails to disclose the structure of the claims, and that Yamakawa does not correct this deficiency. App. Br. 9-12. Appellants further argue that the Examiner erred in rejecting dependent claims 27, 28, 32, and 35 because these claims all depend from independent claim 26, which was not rejected over the combination of Formon and Yamakawa. App. Br. 12.

The issues before us are:

Have Appellants shown the Examiner erred in rejecting claims 1 and 25 as unpatentable over Formon and Yamakawa because the proposed combination fails to render obvious the claimed structure?

Have Appellants shown the Examiner erred in rejecting claims 27, 28, 32, and 35 because the rejection failed to set forth a prima facie case of obviousness of claim 26, from which the rejected claims depend?

The Examiner has also rejected independent claim 40 as being obvious over Denen and Ardalan, and as being obvious over Formon, Yamakawa, and Ardalan. Ans. 10, 7. Appellants advance the same arguments for the patentability of claim 40 as they have for claims 1 and 25 in view of Denen and in view of Formon and Yamakawa. App. Br. 13-14, 15-16. Accordingly, the issues presented with respect to these rejections of claim 40 are the same as those set forth above for claims 1 and 25.

FINDINGS OF FACT

We find that the following enumerated facts are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Appellants' Specification provides a lexicographic definition of the term "identification" as "anything on an object which serves to identify the object." Spec. 4:13-14.
2. Appellants admit that Denen's perforations may be related to absorbent characteristics. App. Br. 6.
3. Appellants admit that Formon's perforations may be related to absorbent characteristics. App. Br. 10.
4. Denen discloses a sheet material dispenser capable of dispensing individual sheets (defined by rows of perforations) from a roll of sheet material. Denen, 1, para. 0001. Denen does not expressly disclose a relationship between perforations in the sheet material and the absorbent characteristics of the sheet material. Denen, *passim*. While a manufacturer of sheet material might define the length of a individual sheet of sheet material with perforation spacing based upon the absorbent characteristics of the sheet material, perforation spacing could also be set at a distance that is unrelated to the absorbent characteristics of the sheet material, such as at a standardized distance.

PRINCIPLES OF LAW

"It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citations omitted). A patent applicant is free to recite features of an apparatus either structurally or functionally. *See In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it

does rather than what it is] in drafting patent claims.”). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). As stated in *Swinehart*, 439 F.2d at 213:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

In rejecting claims under 35 U.S.C. § 103(a), the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

ANALYSIS

Claim Construction

Claim 1. The first element of claim 1 recites a support configured to rotatably support a roll of sheet material which includes identification relating to absorbent characteristics of sheet material on the roll. The claim does not positively recite the roll of sheet material. Rather, the claim calls for only a support configured to (capable of) rotatably support such a roll.

Since the recitation that the roll includes identification relating to absorbent characteristics of the sheet material does not affect the structure of the support necessary to rotatably support such a roll, this recitation in the first element of claim 1 is not given patentable weight.

The second element of claim 1 recites an identifier configured to identify the absorbent characteristics of sheet material on the roll from the identification. This element of claim 1 calls for an identifier that is capable of identifying absorbent characteristics of sheet material based on identification on the roll. Appellants' Specification defines "identifier" as "a mechanism or a device for identifying an object from identification on the object." Spec. 4:15-16. Appellants' Specification describes the identifier in one example as "a reader or scanner" capable of reading a smart tag. Spec. 9:1-15.

The third element of claim 1 recites a processor configured to receive data relating to the absorbent characteristics of the sheet material on the roll and configured to process the data and generate an output command. This element of claim 1 calls for a processor that is programmed to receive and process data relating to absorbent characteristics of the sheet material and generate an output command.

The fourth element of claim 1 calls for a controller configured to control the length of sheet material dispensed from the roll in response to the output command. This element of claim 1 calls for a controller that is capable of receiving a command from the processor, and controlling the length of sheet material dispensed in response.

Claim 25. Independent claim 25 similarly does not positively recite the supply roll and defines the structure of the identifier primarily in terms of

its capability to perform the function of identifying the absorbent characteristics of sheet material on the roll from the identification. Claim 25 also includes a processor that is programmed to receive and process data relating to absorbent characteristics of the sheet material and generate an output command, and a controller capable of controlling the length of sheet material dispensed in response to the output command from the processor.

Claim 40. Independent claim 40 is an apparatus claim that recites a support configured to rotatably support a roll of sheet material which includes identification relating to absorbent characteristics of sheet material on the roll. The claim does not positively recite the roll of sheet material. Rather, the claim calls for only a support configured to (capable of) rotatably support such a roll. Since the recitation that the roll includes identification relating to absorbent characteristics of the sheet material does not affect the structure of the support necessary to rotatably support such a roll, this recitation in the first element of claim 40 is not given patentable weight.

The claim does not recite additional limitations related to the identification or the absorbent characteristics of the sheet material.

Rejection of claims 1, 2, 5-8, 15-19, 21-23, 25-27, 29-31, 34-37, and 39 under 35 U.S.C. § 102(b) as anticipated by Denen

Claims 1, 2, 5-8, 15-19, and 21-23

The Examiner found that Denen discloses: 1) a support (support 12) configured to rotatably support a roll of sheet material which includes identification relating to absorbent characteristics (the perforations 32); 2) an identifier configured to identify the absorbent characteristics of sheet material on the roll from the identification (reader 22); 3) a processor

configured to receive data relating to the absorbent characteristics of the sheet material on the roll and configured to process the data and generate an output command (22, 28, 68, and 24); and, 4) a controller configured to control the length of sheet material dispensed from the roll in response to the output command (22, 28, 68, and 24). Ans. 3. The Examiner also found that the perforations of Denen relate to the absorbent characteristics of the sheet material because the length of each sheet defined by the perforations affects how much liquid the sheet is capable of absorbing. Ans. 3, 10-11.

Appellants do not point to any difference in structure between the claimed invention and Denen's device. App. Br. *passim*. Appellants attempt to distinguish the claimed apparatus from Denen's apparatus because in Denen's apparatus the relationship of the perforations to absorbent characteristics is "not necessarily true or reliable," and thus the perforation sensor of Denen is not properly regarded as being an identifier configured to identify the absorbent characteristics of sheet material from an identification on a roll. App. Br. 6. Appellants admit that Denen's perforations may be related to absorbent characteristics of the sheet material, essentially conceding that, in the case where perforations are related to absorbent characteristics, Denen's device is capable of the claimed function (Fact 2). "It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 128 F.3d at 1477 (citations omitted).

Further, the relationship of the identification (perforations) to absorbent characteristics is defined by claim 1, which requires only an identifier to identify the absorbent characteristics of the sheet material and a processor to receive data relating to those characteristics. Appellants have

failed to persuade us how the claimed device differs structurally from the device disclosed in Denen.

Appellants have failed to show that the Examiner erred in determining that Denen anticipates claim 1. Claims 2, 5-8, 15-19, and 21-23 fall with claim 1.

Claim 25

Appellants argue for the patentability of independent claim 25 by repeating the argument used against the rejection of independent claim 1. App. Br. 7-8. Based on our claim construction, *supra*, we find no distinction in claim 25, and Appellants point to none, warranting deviation from our analysis of this argument against the rejection of claim 1, *supra*, as anticipated by Denen. Appellants have failed to show that the Examiner erred in determining that Denen anticipates claim 25.

Claims 26, 27, 29-31, 34-37, and 39

In contrast to independent claims 1 and 25, independent claim 26 is a method claim rather than an apparatus claim.

The Examiner found that the method of claim 26 was inherent in the operation of the device of Denen. Ans. 11. The Examiner did not find that Denen expressly discloses the step of identifying the absorbent characteristics of sheet material on the roll to generate an output command. Ans. *passim*. While it is possible that the perforations in the sheet material in Denen may represent its absorbent characteristics, it is not clear to us how this step would be inherent, i.e., necessarily present, in Denen because Denen does not necessarily correlate sensing of the perforations to absorbency characteristics of the sheet material (Fact 4). “Inherency, . . . , may not be established by probabilities or possibilities. The mere fact that a

certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and internal quotation marks omitted). As such, we cannot sustain the rejection of claim 26, and the rejection of claims 27, 29-31 and 34-37 also cannot be sustained by virtue of their dependence, directly or indirectly, from claim 26.

While Appellants contend that claim 39 is patentable over Denen because it depends from independent claim 26 (App. Br. 9), this is not the case, because although claim 39 references claim 26, it does not incorporate any limitations from claim 26 therein. Rather, claim 39 recites a roll of sheet material for use in the method of claim 26. As such, claim 39 requires only a roll of sheet material having identification on it that renders the sheet material capable of being used in the method of claim 26. Because Appellants’ assertion that claim 39 depends from claim 26 is legally incorrect, and Appellants have presented no other arguments for the patentability of claim 39, Appellants have not convinced us of error in the Examiner’s rejection of claim 39.

Rejection of claim 14 under 35 U.S.C. § 103(a) as unpatentable over Denen

Appellants repeat the arguments used against the rejection of independent claim 1 as anticipated by Denen to rebut the Examiner’s rejection of claim 14. App. Br. 14. For the reasons explained in the analysis of claim 1 as anticipated by Denen, *supra*, the same argument is unconvincing here.

Rejection of claim 20 under 35 U.S.C. § 103(a) as unpatentable over Denen and Niada

Appellants repeat the arguments used against the rejection of independent claim 1 as anticipated by Denen to rebut the Examiner's rejection of claim 20, adding that Niada does not cure the deficiencies of Denen. App. Br. 14. For the reasons explained in the analysis of claim 1 as anticipated by Denen, *supra*, the same argument is unconvincing here, and there are no deficiencies for Niada to cure.

Rejection of claim 32 under 35 U.S.C. § 103(a) as unpatentable over Denen and Yamakawa; rejection of claim 38 under 35 U.S.C. § 103(a) as unpatentable over Denen and Alfano

Claims 32 and 38 depend, directly or indirectly, from claim 26.

The rejection of claims 32 and 38 each rely on the Examiner's underlying finding of fact that Denen inherently discloses the step of identifying the absorbent characteristics of sheet material on the roll to generate an output command. Ans. 9-10. As we determined in the analysis of claim 26 as anticipated by Denen, *supra*, it is not clear to us how this step would be inherent, i.e., necessarily present, in Denen (Fact 4). Because the Examiner's conclusion of obviousness is based on an erroneous finding of fact, we cannot sustain the rejection of claims 32 and 38.

Rejection of claim 40 under 35 U.S.C. § 103(a) as unpatentable over Denen and Ardalan

Independent claim 40 is an apparatus claim.

Appellants repeat the arguments used against the rejection of

independent claims 1 and 25 as anticipated by Denen to rebut the Examiner's rejection of claim 40, adding that Ardalan does not cure the deficiencies of Denen. App. Br. 15-16. Based on our claim construction, *supra*, we find no distinction between claims 1 and 25 and claim 40, and Appellants point to none, warranting deviation from our analysis of this argument against the rejection of claims 1 and 25, *supra*, as anticipated by Denen. Appellants have failed to show that the Examiner erred in concluding that Denen in combination with Ardalan renders obvious the subject matter of claim 40.

Rejection of claims 1-4, 9, 14-16, 25, 27, 28, 32, and 35 under 35 U.S.C. § 103(a) as unpatentable over Formon and Yamakawa

Claim 1

Appellants' argument here parallels the argument against the anticipation rejection of claim 1, *supra*. App. Br. 9-11. Again, Appellants do not point to any difference in structure between the claimed invention and the proposed combination, and Appellants admit that Formon's perforations may be related to absorbent characteristics (Fact 3). As we concluded in the analysis of claim 1, *supra*, this argument fails to show that the Examiner erred in the rejection of claim 1. Claims 2-4, 9, and 14-16 fall with claim 1.

Claim 25

Appellants' argument here parallels the argument against the anticipation rejection of claim 25, *supra*. App. Br. 11-12. We find no distinction in claim 25, and Appellants point to none, warranting deviation from our analysis of this argument against the rejection of claim 1, *supra*, over Formon and Yamakawa. Appellants have failed to show that the

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Examiner erred in concluding that Formon in combination with Yamakawa renders obvious the subject matter of claim 25.

Claims 27, 28, 32, 35

Claims 27, 28, 32, and 35 depend, directly or indirectly, from claim 26. Independent claim 26 is a method claim.

The Examiner concluded that the proposed combination of Formon and Yamakawa would “perform the recited functions and method steps recited in claims 27, 28, 32, and 35;” however, the Examiner did not specifically find how Formon and Yamakawa meet each of the claimed steps. Ans. 5-6, 12. Appellants assert that the Examiner has not made a *prima facie* case of obviousness because the rejection does not explain how the steps of independent claim 26 are met by the combination of Formon and Yamakawa. See App. Br. 12. We agree. We have no factual findings to review regarding how the combined teachings of the references meet the steps of method claim 26 or its dependent claims 27, 28, 32, and 35, and therefore the Examiner has not made a *prima facie* case of obviousness. We cannot sustain the rejection of claims 27, 28, 32, and 35.

Rejection of claims 10, 11, and 33 under 35 U.S.C. § 103(a) as unpatentable over Formon, Yamakawa, and Narita

Claims 10 and 11

Claims 10 and 11 depend from claim 1.

Appellants argue that the rejection of dependent claims 10 and 11 as unpatentable over Formon, Yamakawa, and Narita is in error because independent claim 1 was not rejected over the same proposed combination. App. Br. 12. The Examiner rejected independent claim 1 over Formon and

Yamakawa, and Appellants failed to show that this rejection was in error. The Examiner rejected claims 10 and 11 over the same combination of Formon and Yamakawa, adding a disclosure from Narita to meet additional limitations of claims 10 and 11. Ans. 4-6, 6-7. Appellants' argument fails to demonstrate error by the Examiner in the rejection of claims 10 and 11.

Claim 33

Claim 33 is a method claim that depends from independent claim 26.

The Examiner found that the method of claim 33 was inherent in the operation of the modified device of Formon and Yamakawa, but did not specifically find how the combination of those references meets each of the claimed steps. Ans. 7. We have no factual findings to review regarding how the combined teachings of the references meet the steps of method claim 33, or of claim 26 from which it depends, and therefore the Examiner has not made a *prima facie* case of obviousness. We cannot sustain the rejection of claim 33.

Rejection of claim 40 under 35 U.S.C. § 103(a) as unpatentable over Formon, Yamakawa, and Ardalan

Appellants repeat the arguments used against the rejection of independent claims 1 and 25 as obvious in view of Formon and Yamakawa to rebut the Examiner's rejection of claim 40, adding that Ardalan does not cure the deficiencies of the proposed combination. App. Br. 13-14. Based on our claim construction, *supra*, we find no distinction between claims 1 and 25, and claim 40, and Appellants point to none, warranting deviation from our analysis of this argument against the rejection of claims 1 and 25, *supra*, as obvious in view of Formon and Yamakawa. Appellants have

failed to show that the Examiner erred in this rejection.

CONCLUSIONS

Appellants have failed to show the Examiner erred in rejecting claims 1 and 25 as anticipated by Denen.

Appellants have shown the Examiner erred in rejecting claim 26 as anticipated by Denen.

Appellants have failed to show the Examiner erred in rejecting claim 1 and 25 as obvious in view of Formon and Yamakawa.

Appellants have shown the Examiner erred in rejecting claims 27, 28, 32, and 35 as obvious in view of Formon and Yamakawa.

DECISION

We AFFIRM the Examiner's decision to reject claims 1-11, 14-23, 25, 39, and 40.

We REVERSE the Examiner's decision to reject claims 26-38.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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